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APPLICATION NO. 157,201,544	FILING DATE 09/30/97	FIRST NAMED INVENTOR SABELAIN	ATTORNEY DOCKET NO. MSK.P-035-US
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EXAMINER BURKE, J

ART UNIT 1642	PAPER NUMBER
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DATE MAILED: 10/04/99

#14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
08/940,544

Applicant(s)

Sadelain et al

Examiner
Julie E. Burke, (Reeves), Ph.D.

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire zero month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to DNA, classified in class 536, subclass 23.4.
 - II. Claims 8-10, drawn to a peptide comprising an antibody variable domain, a signalling domain and a transmembrane domain, classified in class 530, subclass 387.3.
 - III. Claims 11-15, drawn to T cells expressing a recombinant peptide, classified in class 435, subclass 372.3.
 - IV. Claims 16-20, drawn to a method of transducing in a host an immune response by transducing T cells to express a fusion peptide and introducing the transduced T cells into the host, classified in class 514, subclass 44.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I, II and III represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects. The polynucleic acid of Group I, the protein product of Group II, the peptide of Group III, and the T cell expressing the peptide of Group III are all structurally and chemically different from each other. The polynucleotide is made by nucleic acid synthesis, while the peptide may be made by chemical synthesis methods and the host cell is propagated by culture in media. Furthermore, the polynucleotide can be used for hybridization screening, the polypeptide can be used for raising antibodies, the antibody portion of the peptide can be used to immunopurify a polypeptide and the T cell expression

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system can be used to study the regulation of expression of a promoter using the peptide as a marker protein. The examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions I, II and III are patentably distinct.

3. Inventions (I, II and III) and Invention IV are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the the DNA product, the peptide product and the host cell product can be used to practice materially different methods, as set forth above, in addition to the method of inducing the host an immune response to tumor cells. Thus the inventions are patentably distinct.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Nancy Parsons on 30 Sept 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Burke, nee Reeves, Ph.D. whose telephone number is (703) 308-7553.



Julie E. Burke, nee Reeves, Ph.D.

September 30, 1999

JULIE BURKE
PRIMARY EXAMINER